

REMARKS

This Response is filed in reply to the Office Action dated July 22, 2003. In this Response, Applicants traverse the Examiner's rejections of independent claims 1 and 27. Silence with regard to any of the Examiner's rejections is not an acquiescence to such rejections. Specifically, silence with regard to Examiner's rejection of a dependent claim, when such claim depends from an independent claim that Applicants consider allowable for reasons provided herein, is not an acquiescence to such rejection of the dependent claims, but rather a recognition by Applicants that such previously lodged rejection is moot based on Applicants' remarks and/or amendments relative to the independent claim (that Applicants consider allowable) from which the dependent claims depends. Claims 1-52 are pending in the present application.

The issues of the July 22, 2003, Office Action are presented below with reference to the Office Action.

With regard to the Office Action Summary: Applicants note that the Examiner objected to claims 15-17, 26, 41-43, and 52. In the Office Action dated March 17, 2003, the Examiner on page 11 stated that these same claims 15-17, 26, 41-43, and 52 recited allowable subject matter.

With regard to the Office Action, paragraph 5-7: The Examiner rejected claims 22, 23, 48, and 49 under the judicially created doctrine of double patenting over claims 1-12 of U.S. Patent No. 6,569,206 B1. Applicants' claims 22 and 23 depend upon independent claim 1, and claims 48 and 49 depend upon independent claim 27. As provided herein with reference to subsequent paragraphs of the Office Action, Applicants' independent claims 1 and 27 each recite a feature directed to *weighting terms in a text selection by a function $W(t)$ according to the times at which the terms occur relative to the time at which a signal of interest occurs*. This feature is patentably distinct from the claims of the '206 patent, and thus independent claims 1 and 27 are patentably distinct from the '206 patent claims. Further, as provided herein, Applicants consider independent claims 1 and 27 to be allowable, and accordingly, Applicants consider dependent claims 22, 23, 48, and 49 to also be allowable as depending from an allowable base claim. Applicants thus traverse the Examiner's rejection based on obviousness-type double patenting of claims 22, 23, 48, and 49.

With regard to the Office Action, paragraph 9-13: The Examiner rejected:

(1) claims 1-7, 18-19, 27-33, and 44-45 under 35 U.S.C. §103(a) as being unpatentable over Wistendahl et al. (U.S. Patent No. 5,708,845), in view of Bi et al. (U.S. Patent No. 6,311,178 B1) and Giddings (U.S. Patent No. 4,845,697);

(2) claims 8-14 and 34-40 as being unpatentable over Wistendahl et al., Bi et al., and Giddings and further in view of Logan et al. (U.S. Patent No. 6,199,076 B1);

(3) claims 20-21, 24-25, 46-47, and 50-51 under 35 U.S.C. 103(a) as being unpatentable over Wistendahl et al., Bi et al., and Giddings and further in view of Yeomans (U.S. Patent No. 6,182,065 B1); and

(4) claims 22-23 and 48-49 under 35 U.S.C. 103(a) as being unpatentable over Wistendahl et al., Bi et al., Giddings, and Yeomans and further in view of S.E. Robertson et al.

As Examiner knows, and based at least on MPEP 2143, a prima facie case of obviousness under 35 U.S.C. 103(a) requires (1) a suggestion or motivation in the references themselves or generally known in the art, to combine the references, (2) a reasonable expectation of success to combine, and (3) a teaching, via the combination, of all the claimed limitations. *In re Vaeck*, 947 F. 2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants agree with the Examiner's statement on page 4 of the Office action that Wistendahl et al. do not teach feature (c) of Applicants' independent claims 1 and 27. The Examiner also states on page 4 of the Office action that "Bi et al. teach weighting search terms and further teach that this step provides the benefit of giving users search results with which they are more likely to be satisfied." Applicants respectfully disagree, however, with the Examiner's statement on page 4 that "Giddings would have suggested to one of ordinary skill in the art combining and extending Wistendahl et al. and Bi et al. to use a function $W(t)$ according to the time t at which the term occurs relative to the time at which the signal of interest occurs," as such feature is claimed by Applicants in independent claims 1 and 27.

Giddings provides no teaching of the *time at which a search term occurs*. Rather, Giddings teaches *searching* for a search term *for a fixed time duration*. More specifically, Giddings teaches a system and method for locating a target track on a videodisc in which the identifier for the target track is unrecognizable. Starting from track number zero, Giddings teaches searching ascending track numbers for the target track until the system recognizes that the target track has been passed, at which point the system searches descending track numbers for the target track. This ascending and descending search continues for a *fixed time duration*, at

the end of which the system abandons the search for the target track and begins to search for a track adjacent to the target track by *employing the inherent relationship of a numbering system to identify adjacent tracks* (Giddings, FIG. 6; col. 15, line 47 - col. 16, line 23). With reference to Applicants' independent claims 1 and 27, the "search terms" in Giddings are the numeric track identifiers. Giddings teaches searching for the search terms for a *fixed time duration*, which is not the same as the *time at which a search term occurs*, as in Applicants' independent claims. Moreover, the *ascending and descending search* through a numbered system of track numbers is also not the same as *the time at which a search term occurs*. Giddings thus provides no teaching of the *time at which a search term occurs*, as claimed in Applicants' independent claims 1 and 27, but rather, only a search area for a track number based on a known, inherent numerical relationship.

Giddings thus does not provide any teaching of *the time at which a search term occurs*. Applicants further note Examiner's own statements on page 4, in which Examiner states that Bi et al. only teach weighting, and Wistendahl et al. do not teach any component of feature (c) of Applicant's independent claims 1 and 27. Because none of the cited references, alone or in combination, teaches the time at which a search term occurs, the cited references cannot teach *weighting search terms according to the time at which the term occurs relative to the time at which a signal of interest occurs*, as claimed by Applicants in independent claims 1 and 27. Examiner fails to establish a prima facie case of obviousness under 35 U.S.C. 103(a) at least for failing to show that all elements of Applicants' claims would be satisfied by the combination.

Applicants also note that in addition to and regardless of Examiner's failure to satisfy all elements of the claimed combination, Examiner also fails to provide a motivation for the proposed combination. As stated recently by the CAFC, *In Re Sang Su Lee* (January 18, 2002, 00-1158), quoting *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), "the examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" In the present Office Action, Examiner fails to provide such motivation (e.g., objective teaching, or generally available knowledge) for any of the rejections, stating merely that "it would have been obvious" to combine references. In such statements (e.g., Office action, page 4), the Examiner states an advantage of the Applicants' combination, without reference to

any motivation such as objective teaching and/or knowledge generally available to one skilled in the art, as is required.

“Teachings of references can be combined only if there is some suggestion or incentive to do so,” (emphasis in original) In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988), quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). “Even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious,” In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998)

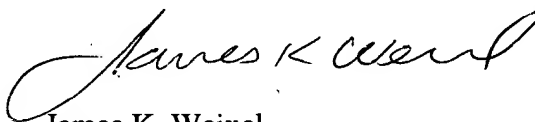
At least because the Examiner fails to show a combination that teaches feature (c) of Applicants’ independent claims 1 and 27, and further because Examiner fails to provide motivation for any proposed combination, Examiner fails to satisfy the prima facie case of obviousness under 35 U.S.C. 103(a). Applicants’ failure to address the Examiner’s failure to show a reasonable expectation of success of the purported combination is not an acquiescence to such element of the prima facie case of obviousness, but rather a recognition by Applicants that such element is moot given the Examiner’s failure to show the all elements and motivation portions of the prima facie showing of obviousness under 35 U.S.C. 103(a).

Applicants thus traverse Examiner’s rejection of independent claims 1 and 27, and consider independent claims 1 and 27 to be allowable. Claims 2-26 depend upon allowable independent claim 1, and claims 28-52 depend upon allowable independent claim 27, and thus, claims 2-26 and 28-52 are also allowable for depending upon an allowable base claim.

Conclusion

Applicants consider the Response herein to be fully responsive to the referenced Office Action. Based on the above Remarks, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If there are any remaining issues or the Examiner believes that a telephone conversation with Applicants' attorney would be helpful in expediting the prosecution of this application, the Examiner is invited to call the undersigned at (781) 466-2220.

Respectfully submitted,



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